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a network for communicating user identification data and account information with a remote location,

wherein the function code defines a function for automatically accessing the automated financial transaction machine.

### REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed August 28, 2002. Upon entry of the foregoing amendments in this response, claims 26-31 remain pending in the present application. In addition, claims 26 and 29 have been amended.

In the Office Action, claims 26-31 stand preliminarily rejected under 35 U.S.C. §103(a). The Applicant respectfully traverses all of the rejections of the Office Action. Reconsideration and allowance of the application and presently pending claims 26-31 are respectfully requested.

#### **I. Response To §103 Rejections**

In the Office Action, claims 26-28, 30, and 31 have been preliminarily rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,714,931, to Petite *et al.* (hereafter, "*Petite*"). In addition, claim 29 has been preliminarily rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,550,358, to Tait *et al.* (hereafter, "*Tait*") in view of U.S. Patent No. 5,319,364, to Waraksa *et al.* (hereafter, "*Waraksa*").

In order for a claim to be properly rejected under 35 U.S.C. §103, the combined teachings of the prior art references must suggest all features of the claimed invention to one of ordinary skill in the art. See, e.g., *In re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988), and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981). The Applicant respectfully submits that

*Petite* fails to disclose, teach, or suggest each element of claims 26-28, 30, and 31, and *Tait* in view of *Waraksa* fails to disclose, teach, or suggest each element of claim 29 for the reasons that follow. However, prior to describing the above-mentioned failures, a discussion of the *Petite* reference, the *Tait* reference, and the *Waraksa* reference is offered.

**A. Discussion of the *Petite* Reference**

*Petite* discloses a personal security system in which a portable transmitter may be carried or worn by an individual and activated by the individual in need of assistance to transmit data relating specifically to the individual. The data is received by a transceiver located nearby to the individual and transmitted with additional data to a remote receiver. The remote receiver then forwards information relating to the data to emergency personnel who use the information to determine the location of the individual, as well as particulars relating specifically to the individual, such as a name and a physical description.

**B. Discussion of the *Tait* Reference**

*Tait* appears to disclose a remote wireless transaction system having a hand-held transmitter that contains a digital memory device that stores unique user information. The transmitter apparently has a keypad to allow a user to key-in a unique PIN number that is stored in the transmitter. If the keyed-in PIN number is the same as the PIN number stored in the transmitter, the unique user information is transmitted to a receiver that is coupled to a conventional card swipe machine.

The receiver on the card swipe machine has a display panel that displays contents of an identity part of the user information. A vendor then confirms the user's identity and allows a transaction associated with the transmission to proceed. Apparently, even if the transmitter does not have a keypad, the vendor still confirms the user's identity.

**C. Discussion of the *Waraksa* Reference**

*Waraksa* appears to disclose an automotive keyless entry system that is adapted to automatically unlock a vehicle as an operator approaches the vehicle. The system disclosed by *Waraksa* apparently provides a passive keyless entry system that employs signal transmission and coding techniques that provide a high level of noise immunity and signal discrimination. The passive keyless entry system contains a transmitter or beacon, a receiver/controller, and a receiving antenna. Apparently, upon receipt of a radio frequency signal from the antenna, the receiver/controller is adapted to process the coded radio frequency signal and evaluate serial data contained therein. If the signal is determined to be valid, the receiver/controller automatically unlocks a driver's-side vehicle door.

In addition, *Waraksa* appears to disclose that the beacon may be provided with function switches which, when depressed by an operator, change function code contained in the radio frequency signal, thereby directing the receiver/controller to perform other functions on the vehicle. The function code is a 4-bit function code that provides up to sixteen different function codes to selectively control activation of the additional vehicle functions.

**D. Claim 26**

Amended claim 26 reads:

26. An automated teller banking system, comprising:  
a remote access unit having:  
a first user-depressable button;  
a memory configured to store user identification data, including track one and track two data;  
***a low-power wireless transmitter; and***  
a controller configured to control the wireless transmitter to transmit the user identification data stored in the memory in direct response to a manual depression of the first user-depressable transmit button, without any verification of user identification data;  
***data formatting logic configured to format the user identification data, the data formatting logic being disposed to receive input from both the controller and the memory and to generate an output for the wireless transmitter; and***  
an automated teller banking machine having:  
a receiver configured to receive wireless transmissions from a remote access unit;  
a mechanism for reading information from a magnetic strip of a banking card;  
data formatting logic disposed to receive an output from both the mechanism for reading information and the receiver; and  
logic to verify account information for a user and an account identified by the user identification information; and  
a network coupled to the automated teller banking machine for communicating account information, user information, and other information with a remotely-located database.

*(Emphasis Added).*

The Applicant respectfully submits that *Petite* fails to disclose, teach, or suggest at least the above-emphasized elements. Particularly, *Petite* fails to disclose, teach, or suggest the elements of: a low-power wireless transmitter, and data formatting logic configured to format the user information data, the data formatting logic being disposed to receive input from both the controller and the memory and to generate an output for the wireless transmitter.

Column 3, lines 44-46 of *Petite* read, “[T]he transmitter 230 transmits an FSK tone modulation signal 115 (see FIG. 1), similar to that of a cellular phone, which preferably reaches a **minimum of 150 feet away.**” The Applicant respectfully submits that *Petite* does not disclose, teach, or suggest use of a low-power transmitter.

Page 10, lines 13-18 of the presently pending application further describe why a low-power transmitter is utilized. Page 10, lines 13-18 read:

Preferably, the transmitter 20 is an extremely low power transmitter, so that a user will have to be in close proximity, (e.g., several feet) to the receiver 18 of an AFTM 10 in order to use the transmitter. This would help alleviate problems which may otherwise occur if a user approaching an AFTM 10 is circumvented by a second, more distantly located user who depresses his transmit button. This extremely low-power operation helps to prevent the unlawful interception of the electromagnetic signals.

As mentioned above, proximity of the user to the receiver is important not only for convenience purposes, but also for security purposes.

In addition, *Petite* does not disclose, teach, or suggest data formatting logic configured to format the user information data, the data formatting logic being disposed to receive input from both the controller and the memory and to generate an output for the wireless transmitter. In fact, *Petite* simply transmits a signal after pressing of the two or more buttons located on a portable transmitter device. As an example, column 3, lines 1 – 5 of *Petite* read:

...The system 100 includes a portable transmitter device 120, a transceiver 130, and a remote receiver 140. The portable transmitter device 120 transmits a signal 115 containing data specific to an individual to the transceiver 130.

Further, column 3, lines 34-37 of *Petite* read:

When a top button 210 and bottom button 220 are then pressed simultaneously, the transmitter is activated and a signal containing the type of emergency condition is sent to the transceiver 130 (see FIG. 1).

Therefore, since Petite does not disclose, teach, or suggest the above-emphasized elements, the Applicant respectfully requests that claim 26 be allowed.

**E. Claims 27 and 28**

The Applicant respectfully submits that pending dependent claims 27 and 28 contain all elements and features of their respective independent claim 26. Since independent claim 26 should be allowed, as argued hereinabove, pending dependent claims 27 and 28 should be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

**F. Claim 29**

Amended claim 29 reads:

29. A system for providing cardless access to a financial transaction machine, comprising:

***a remote access device*** having a single user-depressible button, a memory configured to store user identification data, including track one and track two data and a function code, a low-power transmitter, and a controller configured to control the transmitter to ***transmit*** the track one and track two data and ***function code in direct response to a manual depression of the user-depressable transmit button***, without any verification of user identification data;

an automated financial transaction machine having a magnetic card reader and receiving means for receiving the data and the function code transmitted from the remote access device via electromagnetic waves, and data formatting means responsive to outputs from both the receiving means and card reading means for obtaining user identification information therefrom; and

a network for communicating user identification data and account information with a remote location,

***wherein the function code defines a function for automatically accessing the automated financial transaction machine.***

*(Emphasis Added)*

The Applicant respectfully submits that *Tait* in view of *Waraksa* fails to disclose, teach, or suggest at least the above-emphasized element. Particularly, *Tait* in view of *Waraksa* fails to disclose, teach, or suggest the element of the remote access device transmitting a function code in direct response to a manual depression of the user-depressible transmit button, wherein the function code defines a function for automatically accessing the automated financial transaction machine.

In preliminarily rejecting claim 29, the Office Action reads:

Claim 29 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Tait et al* (US 5,550,358) in view of *Waraksa et al* (US 5,319,364), both of record.

*Tait et al* disclose (1) a remote access device for accessing a financial transaction machine comprising a single user-depressible button, a memory for storing user identification data (including track 1 and track 2 data), a transmitter and a controller; (2) an automatic financial transaction machine with a magnetic card reader, and receiving means for receiving data transmitted from the remote access device via electromagnetic waves, and data formatting means responsive to outputs from the receiving means and the card reader; and (3) a network for communicating user identification data and account information. Applicant's attention is directed to the embodiment of the invention in Fig. 5 and the text pertaining thereto in column 6. The embodiment of Fig. 5 does not require prior verification of user identification data. The user identification data is transmitted in response to the depression of the single user-depressible button. *Tait et al* fails to specifically disclose the transmission of a function code along with user identification data in response to the depression of the user button.

*Waraksa et al* disclose a remote access unit in which a transmitter transmits a function code along with an identification code. Applicant's attention is directed to the text under the heading "ERROR CORECTION CODE" in columns 5-7 of *Waraksa et al*.

For clarification purposes, the Applicant has amended claim 29 to include the language, "wherein the function code defines a function for automatically accessing the automated financial transaction machine." Neither *Tait*, nor *Waraksa* discloses, teaches, or suggests the above-emphasized element.

As mentioned above, *Tait* appears to disclose a remote wireless transaction system as having a hand-held transmitter that contains a digital memory device that stores unique user information. The transmitter apparently has a keypad to allow a user to key-in a unique PIN number that is stored in the transmitter. If the keyed-in PIN number is the same as the PIN number stored in the transmitter, the unique user information is transmitted to a receiver that is coupled to a conventional card swipe machine. The receiver on the card swipe machine has a display panel that displays contents of an identity part of the user information. A vendor then confirms the user's identity and allows a transaction associated with the transmission to proceed. Apparently, even if the transmitter does not have a keypad, the vendor still confirms the user's identity.

Alternatively, as has been recited by claim 29 of the presently pending application, the low-power transmitter located within the remote access device transmits a function code in direct response to manual depression of a user-depressible transmit button, wherein the function code defines a function for automatically accessing the automated financial transaction machine. Therefore, due to the function code, the system as recited by claim 29, does not require assistance or verification by a vendor or any other party, as is disclosed by *Tait*. Instead, automatic access to the automated financial transaction machine is provided. Of course, as is also recited by claim 29, the received data comprising the track one and track two data is also received by the receiver.

As is also mentioned above, *Waraksa* appears to disclose an automotive keyless entry system that is adapted to automatically unlock a vehicle as an operator approaches the vehicle. Apparently, upon receipt of a radio frequency signal from an antenna, a receiver/controller is adapted to process the coded radio frequency signal and evaluate serial data contained therein. If the signal is determined to be valid, the receiver/controller automatically unlocks a driver's-side



vehicle door. In addition, *Waraksa* appears to disclose that the beacon may be provided with function switches which, when depressed by an operator, change function code contained in the radio frequency signal, thereby directing the receiver/controller to perform other functions on the vehicle. The function code is a 4-bit function code that provides up to sixteen different function codes to selectively control activation of the additional vehicle functions.

*Waraksa* does not disclose, teach, or suggest the element of the remote access device transmitting a function code in direct response to a manual depression of the user-depressible transmit button, wherein the function code defines a function for automatically accessing the automated financial transaction machine. The Applicant respectfully submits that the function code disclosed by *Waraksa* is not the same as the function code recited in claim 29 of the presently pending application. As mentioned above, the different function code in *Waraksa* controls activation of vehicle functions, and does not provide for automatic accessing of an automated financial transaction machine. Since, neither *Tait*, nor *Waraksa*, discloses, teaches, or suggests the above-emphasized element, *Tait* in view of *Waraksa* does not render claim 29 unpatentable and claim 29 should be allowed.

Further, and as a separate and independent basis for the patentability of claim 29, the Office Action fails to cite an appropriate suggestion, teaching, or motivation to combine the alleged teachings of *Tait* and *Waraksa*. It is well-settled law that in order to properly support an obviousness rejection under 35 U.S.C. §103, there must have been some teaching in the prior art to suggest to one skilled in the art that the claimed invention would have been obvious. *W. L. Gore & Associates, Inc. v. Garlock Thomas, Inc.*, 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

"The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. ..." Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure... In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention."

(*Emphasis added.*) *In re Dow Chemical Company*, 837 F.2d 469, 473 (Fed. Cir. 1988).

In this regard, the Applicant notes that there must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also requires the prior art to suggest both the combination of elements and the structure resulting from the combination. *Stiftung v. Renishaw PLC*, 945 Fed.2d 1173 (Fed. Cir. 1991). Therefore, in order to sustain an obviousness rejection based upon a combination of any two or more prior art references, the prior art must properly suggest the desirability of providing a remote access device that transmits a function code in direct response to a manual depression of a user-depressible transmit button, wherein the function code defines a function for automatically accessing an automated financial transaction machine, as claimed by the Applicant. "Particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed." *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

"A showing of a suggestion, teaching, or motivation to combine the prior art references is an essential component of an obviousness holding." *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed.Cir.2000)) (*quoting C.R. Bard, Inc., v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed.Cir.1998)); The Federal Circuit has made it clear "that the best defense against the subtle

but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."); In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed.Cir.1999). Thus, there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant." In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed.Cir.1998).

As has been described in detail above, *Tait* is directed to a remote wireless transaction system, while *Waraksa* is directed to a passive keyless entry system for an automobile. The Applicant respectfully submits that neither *Tait*, nor *Waraksa*, provides a motivation to combine the teachings of these references. For the above reason, the Applicant respectfully requests that claim 29 be allowed.

**G. Claim 30**

Claim 30 reads:

30. An automated teller banking system, comprising:  
a remote access unit having:  
a first user-depressable button;  
a memory configured to store user identification data, including track one and track two data;  
***a low-power wireless transmitter; and***  
a controller configured to control the wireless transmitter to transmit the user identification data stored in the memory in direct response to a manual depression of the first user-depressable transmit button, without any verification of user identification data;  
***data formatting logic configured to format the user identification data, the data formatting logic being disposed to receive input from both the controller and the memory and to generate an output for the wireless transmitter.***

(Emphasis Added).

The Applicant respectfully submits that *Petite* fails to disclose, teach, or suggest at least the above-emphasized elements. Particularly, *Petite* fails to disclose, teach, or suggest the elements of: a low-power wireless transmitter, and data formatting logic configured to format the user identification data, the data formatting logic being disposed to receive input from both the controller and the memory and to generate an output for the wireless transmitter.

Column 3, lines 44-46 of *Petite* read, “[T]he transmitter 230 transmits an FSK tone modulation signal 115 (see FIG. 1), similar to that of a cellular phone, which preferably reaches a **minimum of 150 feet away.**” The Applicants respectfully submit that *Petite* does not disclose, teach, or suggest use of a low-power transmitter.

Page 10, lines 13-18 of the presently pending application further describe why a low-power transmitter is used. Page 10, lines 13-18 read:

Preferably, the transmitter 20 is an extremely low power transmitter, so that a user will have to be in close proximity, (e.g., several feet) to the receiver 18 of an AFTM 10 in order to use the transmitter. This would help alleviate problems which may otherwise occur if a user approaching an AFTM 10 is circumvented by a second, more distantly located user who depresses his transmit button. This extremely low-power operation helps to prevent the unlawful interception of the electromagnetic signals.

As mentioned above, proximity of the user to the receiver is important not only for convenience purposes, but also for security purposes.

In addition, *Petite* does not disclose, teach, or suggest data formatting logic configured to format the user information data, the data formatting logic being disposed to receive input from both the controller and the memory and to generate an output for the wireless transmitter. In fact, *Petite* simply transmits a signal after pressing of the two or more buttons located on a portable transmitter device. As an example, column 3, lines 1 – 5 read:

...The system 100 includes a portable transmitter device 120, a transceiver 130, and a remote receiver 140. The portable transmitter device 120 transmits a signal 115 containing data specific to an individual to the transceiver 130.

Further, column 3, lines 34-37 of *Petite* read:

When a top button 210 and bottom button 220 are then pressed simultaneously, the transmitter is activated and a signal containing the type of emergency condition is sent to the transceiver 130 (see FIG. 1).

Therefore, since *Petite* does not disclose, teach, or suggest the above-emphasized elements, the Applicant respectfully requests that claim 30 be allowed.

#### **H. Claim 31**

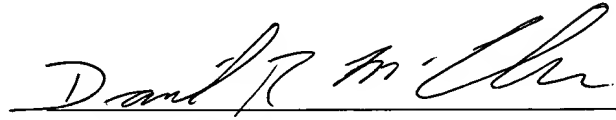
The Applicant respectfully submits that pending dependent claim 31 contains all elements and features of its respective independent claim 30. Since independent claim 30 should be allowed, as argued hereinabove, pending dependent claim 31 should be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

#### **CONCLUSION**

In light of the foregoing amendment and for at least the reasons set forth above, the Applicant respectfully submits that all rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 26-31 are in condition for allowance. Therefore, the Applicant respectfully requests that all outstanding rejections be withdrawn and that this application and all presently pending claims be allowed to issue.

If the Examiner has any questions or comments regarding the Applicant's response, the Examiner is encouraged to telephone the Applicant's undersigned counsel.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Daniel R. McClure", written over a horizontal line.

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**ANNOTATED VERSION OF MODIFIED CLAIMS TO SHOW CHANGES MADE**

The following is a marked version of the amended claims. Amend the following claims by adding the language that is underlined (“   ”) and by deleting the language that is enclosed within brackets (“[ ]”):

26. (Once Amended) An automated teller banking system, comprising:

a remote access unit having:

a first user-depressable button;

a memory configured to store user identification data, including track one and track two data;

a low-power wireless transmitter; and

a controller configured to control the wireless transmitter to transmit the user identification data stored in the memory in direct response to a manual depression of the first user-depressable transmit button, without any verification of user identification data;

data formatting logic configured to format the user identification data, the data formatting logic being disposed to receive input from both the controller and the memory and to generate an output for the wireless transmitter; and

an automated teller banking machine having:

a receiver configured to receive wireless transmissions from a remote access unit;

a mechanism for reading information from a magnetic strip of a banking card;

data formatting logic disposed to receive an output [form] from both the mechanism for reading information and the receiver; and

logic to verify account information for a user and an account identified by the user identification information; and

a network coupled to the automated teller banking machine for communicating account information, user information, and other information with a remotely-located database.

29. (Once Amended) A system for providing cardless access to a financial transaction machine, comprising:

a remote access device having a single [user-depressable] user-depressible button, a memory configured to store user identification data, including track one and track two data and a function code, a low-power transmitter, and a controller configured to control the transmitter to transmit the track one and track two data and function code in direct response to a manual depression of the [user-depressable] user-depressible transmit button, without any verification of user identification data;

an automated financial transaction machine having a magnetic card reader and receiving means for receiving the data and the function code transmitted from the remote access device via electromagnetic waves, and data formatting means responsive to outputs from both the receiving means and card reading means for obtaining user identification information therefrom; and

a network for communicating user identification data and account information with a remote location,

wherein the function code defines a function for automatically accessing the automated financial transaction machine.